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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,302	06/23/2000	Allen B. Childress	5053-35700	1770

7590 07/22/2003

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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,302

Applicant(s)

CHILDRESS, ALLEN B.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 and 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 14 May 2003. Claims 1-113 are pending. Claims 4, 10, 26, 28, 29, 33, 40, 46, 68, 73, 83, 86, 91, 99, 100, 108, and 110 have been amended. Claims 111-113 are newly added.

Specification

2. The objections to the specification are hereby withdrawn due to the amendment filed 14 May 2003.

Claim Objections

3. The objections to claim 28 are hereby withdrawn due to the amendment filed 14 May 2003.

Claim Rejections - 35 USC § 101

4. The rejections of claims 81-110 under 35 USC 101 are hereby withdrawn due to the amendment filed 14 May 2003. However, it is noted that the recitation of "program instructions... computer-executable to implement" in claim 81 is interpreted to mean the program instructions are "embodied on a computer."

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (5,655,085) in view of Brooks et al. (4,992,972) for substantially the same reasons given in the previous Office Action (see paper number 5). Further reasons appear below.

(A) Claims 1-3, 5-9, 11-25, 27, 30-32, 34-39, 42-45, 47-67, 69-72, 74-82, 84-85, 87-90, 92-98, 101-107, and 109 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5), and incorporated herein.

(B) The amendments to claims 4, 33, 46, and 83 appear to include the deletion of "in each of the one or more help information tables" and the changing of "comprising" to "comprises". It is respectfully submitted that, since the underlying processes and systems of claims 4, 33, 46, and 83 had been shown to be either performed by or obvious in view of the teachings of Ryan and Brooks in the prior Office Action (paper number 5, section(A)), it is readily apparent that the amendments do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous

Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section(A)), and incorporated herein.

(C) Claims 10, 29, 40, 86, 100, and 108 appear to have been amended to change "the user entering" a first term to "receiving" a first term. It is respectfully submitted that a user entering a first term into a search interface includes the interface receiving the term. Therefore, the amendments do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section(A)), and incorporated herein.

(D) The amendment to claim 26 appears to have been made to remove the term "each". The amendments do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section(A)), and incorporated herein.

(E) The amendments to claims 28, 68, and 99 appear to include the deletion of "each of help information in each of the located". It is respectfully submitted that, since the underlying processes and systems of claims 28, 68, and 99 had been shown to be

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either performed by or obvious in view of the teachings of Ryan and Brooks in the prior Office Action (paper number 5, section(A)), it is readily apparent that the amendments do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section(A)), and incorporated herein.

(F) The amendments to claim 73 appear to have been made to the rearrange the order of claim elements, but otherwise do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action. As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section(A)), and incorporated herein.

(G) Applicant states in the response filed 14 May 2003 that claim 110 has been amended. However, it appears that claim 110 has not been amended. Therefore, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 5, section(A)), and incorporated herein.

7. Claims 111-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (5,655,085) in view of Brooks et al. (4,992,972).

(A) Newly added claims 111-113 include the limitation of “the first unit of help information and the display page for the first step” being “displayed on the display at the same time.” As per this newly added limitation, Ryan discloses providing a computerized help system, preferably a context sensitive, hypertext-linked help system, available from any screen in the system, wherein the system includes a FMA_HELP entity containing all context sensitive, hypertext linked help records including context keywords and hyperlink keywords in addition to the help text that enables these features, and wherein the entity is part of a relational database (reads on “an index table”) (Fig. 3C-1 and 4A, col. 14 lines 37-40, col. 23 lines 1-5, col. 24 lines 1-20, and col. 26 lines 20-50). Although Ryan and Brooks do not explicitly state the first unit of help information and the display page of the first step being displayed at the same time, it is respectfully submitted that typical help systems present both the help system and the current application a user is working in simultaneously, and therefore it would have been an obvious modification to the method or system of Ryan and Brooks to include displaying help information and a display page at the same time with the motivation of ensuring a user does not have to exit an application when using the help system thus increasing usability and user friendliness of the system and reducing the amount of time required to use the help system.

Response to Arguments

8. Applicant's arguments filed 14 May 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 14 May 2003.

(A) At pages 55-57 of the 14 May 2003 response, Applicant argues that the applied references do not teach the feature of processing insurance claims. Further, Applicant argues that the teachings of Ryan with regards to "a method of using a digital computer for initiating, processing, preparing, storing, and transmitting illustrations of universal life insurance..." are not equivalent to Applicant's feature of "processing of an insurance claim."

In response, the Examiner respectfully notes that the cited references were never applied as references under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988)

(citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, Ryan teaches a method using a digital computer for initiating, processing, preparing, storing, and transmitting illustrations of universal life insurance, wherein the computer is operable by connecting to a database and at least one other digital computer, including input and display apparatus to permit data to be entered in and retrieved from the database (Abstract) comprising entering first data representing a

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first universal life insurance policy (col. 48 lines 8-41), and providing a computerized help system, preferably a context sensitive, hypertext-linked help system, available from any screen in the system, wherein the system includes a FMA_HELP entity containing all context sensitive, hypertext linked help records including context keywords and hyperlink keywords in addition to the help text that enables these features, and wherein the entity is part of a relational database (reads on "an index table") (Fig. 3C-1 and 4A, col. 14 lines 37-40, col. 23 lines 1-5, col. 24 lines 1-20, and col. 26 lines 20-50), as clearly set in the prior Office Action (see paper number 5).

As such, it is respectfully submitted that Applicant appears to view the applied references in a vacuum without considering the knowledge of average skill in the art.

In reference to Applicant's specific arguments with respect to the Ryan teachings not being equivalent to Applicant's feature of "processing of an insurance claim," it is respectfully submitted that Applicant's own specification does not provide a positive definition of the processing of an insurance claim. Instead, Applicant's support for the definition of the processing of an insurance claim (namely page 13, lines 13-26) appears to include broad and non-specific references to the processing of insurance claims. Specifically, the cited passages use non-committal language that only describes features which "may be used", "may pertain to", "may file", "may utilize", and "may include" in the claimed processing of insurance claims in various embodiments. Such descriptions fail to define the required features of insurance claims processing. As such, the Examiner has given the claim language the broadest reasonable interpretation and has applied art according, and therefore, Ryan's disclosure of

preparing and processing universal life insurance applications (col. 1 lines 11-17) is considered to be a form of Applicant's definition of insurance claim processing.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

11. Any response to this action should be mailed to:


Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703) 746-8374	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB
CB
July 15, 2003


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600